THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOYUKI KIDA

Appeal No. 1997-3694
Application No. 08/277,013

ON BRIEF

Before KRASS, LALL, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of Claims 1, 4, and 6-10.

We reverse.

BACKGROUND

The invention is directed to a system for mounting electronic parts on a structure such as a printed circuit board. Claim 1 is reproduced below.

> 1. A mounting system for mounting an electronic part on a mounting body by aligning leads of said electronic part with corresponding bonding terminals of said mounting body, said leads being arranged on four sides of said electronic part, said system comprising:
>
> positional-data forming means for forming positional data of said leads and said bonding terminals;
>
> line arithmetic means for calculating, from said positional-data, lead lines representing rows of said leads of said electronic part and bonding lines corresponding to said lead lines and representing rows of said bonding terminals;
>
> base-point/base-line arithmetic means for calculating base points and base lines of said electronic part and of said mounting body, said base lines[1] being calculated as diagonal lines of a rectangle defined by said four sides, and said base point being calculated as an intersection point between said diagonal lines of said rectangle;
>
> position/angle arithmetic means for calculating positional-interrelationship between base points of said electronic part and said mounting body and intersection angles between the base lines of said electronic part and said mounting body; and
>
> position/angle control means for controlling interrelationship in position and angle between said electronic part and said mounting body based on said positional interrelationship and said intersection angles.

[1] In the appendix of claims submitted with the Brief, "lines" is misspelled as "liens."

The examiner relies on the following admitted prior art (see Answer, page 2):

Applicant's admitted prior art, page 1, line 8 to page 7, line 9, and prior art figures 9, 10, 11(a), and 11(b).

Claims 1, 4, and 6-10 stand rejected under 35 U.S.C. § 102 over the admitted prior art.

We refer to the Final Rejection (Paper No. 12) and the Examiner's Answer (Paper No. 16) for a statement of the examiner's position and to the Brief (Paper No. 15) and the Reply Brief (Paper No. 17) for appellant's position.

OPINION

Grouping of Claims

Appellant states that the claims should not be presumed to stand or fall together (Brief, page 11), and presents arguments for each claim. Accordingly, each claim on appeal stands or falls separately. See 37 CFR § 1.192(c)(7).

The Rejection

The examiner, on page 3 of the Answer, relates claim limitations to structures disclosed in appellant's admitted prior art portion of the specification. The examiner contends that prior art structures comprise the "equivalent" of elements recited in the instant claims.

Appellant argues, inter alia, that the claims are drafted in "means plus function" format, and should be construed "to cover the corresponding structure, material, or acts described in the

specification and equivalents thereof." (Brief, page 12.) On pages 8 through 10 of the Brief, in the "Summary of Invention" section, appellant relates claim language to embodiments disclosed in the specification. We agree with appellant that, for anticipation, "each element of the claimed invention must be identically shown, or at least have a structural equivalent capable of performing the same function." (Brief, page 13.)

The examiner's error appears to be in equating structures in the admitted prior art with instant claim language on the basis of similarity in the overall functions performed -- that is, using algorithms for positioning electronic parts on a mounting body. However, before reaching consideration of possible structural "equivalents," a prior art structure must have an identity of function, or at least be capable of performing the function, associated with the claimed element. An element-by-element comparison with the prior art is necessary.

> Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. Furthermore, with an element expressed in terms of a means plus function, "absent structure [in a prior art reference] which is capable of performing the functional limitation of the 'means,' [the prior art reference] does not meet the claim."

RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)(citations omitted).

> Anticipation is determined by comparison of the reference with the claims. The claims here define the invention in terms of several specific "means-plus-function" elements. The limitations which must be met by an anticipatory reference are those set forth in each statement of function. In re Mott, 557 F.2d 266, 269, 194 USPQ 305, 307

> (CCPA 1977). Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept.

RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d at 1445 n.5, 221 USPQ at 389, n.5.

The examiner's allocation of burdens, as set forth on page 4 of the Answer, is misplaced. In certain circumstances, burden may shift to an applicant to show that a prior art structure does not inherently possess the functionally defined limitations of the applicant's claimed apparatus. However, more is required than that the claims "stand rejected as being anticipated." A prima facie case of anticipation must be established before the burden shifts to an applicant. See In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986); In re Best, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1976); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Because the examiner has merely referred to prior art structures as "equivalent" to claimed elements, a prima facie case of anticipation has not been established.

The USPTO guidelines for examination of 35 U.S.C. § 112, sixth paragraph "means or step plus function" limitations in a claim, and in particular the section entitled "Making a prima facie case of equivalence," are also relevant. The prerequisite for placing the burden on an applicant to show that a prior art element is not an equivalent of disclosed structures is finding the particular "function" in the prior art.

> If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983).

U.S Patent and Trademark Office, 1186 Official Gazette 86 (September 27, 1994)(footnote omitted). See also Manual of Patent Examining Procedure, § 2183, Seventh Edition, July 1998 (containing identical language).

In the instant case, the examiner has not explained how the prior art elements might be capable of performing each of the claimed functions that appear at least in independent Claims 1, 6, and 9. The assertion on page 4 of the Answer that the functions are "inherent" in the prior art because the prior art structures are capable of "performing algebraic calculations" is inconsistent with the law of our reviewing court. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim limitations regarding organization of data in memory held to distinguish over prior art). See also In re Alappat, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994)(commenting that prior cases held that computer, once programmed, creates a new machine); In re Noll, 545 F.2d 141, 148, 191 USPQ 721, 726 (CCPA 1976)("[The claimed invention] comprises physical structure, including storage devices and electrical components uniquely configured to perform specified functions

through the physical properties of electrical circuits to achieve controlled results. Appellant's programmed machine is structurally different from a machine without that program.")

For the reasons above, the rejection of Claims 1, 4, and 6-10 is not sustained.

CONCLUSION

The rejection of Claims 1, 4, and 6-10 is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
PARSHOTAM S. LALL	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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